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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,031	09/24/2003	James L. Bullington	PRD-0042-USNP	5017

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EXAMINER

WARD, PAUL V

ART UNIT PAPER NUMBER

1624

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,031	<b>Applicant(s)</b> BULLINGTON ET AL.	
	<b>Examiner</b> PAUL V. WARD	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. The compounds according to claim 1 of formula I, wherein  $R^3$  is H, alkyl, -N=CR'', -C(O)R', -C(O)NR'R'', or -NR'R''. These are classifiable in subclass 544, subclass 400+.
- II. The compounds according to claim 1 of formula I, wherein  $R^3$  is an aryl. These are classifiable in subclass 544, subclass various.
- III. The compounds according to claim 1 of formula I, wherein  $R^3$  is five-membered heterocyclic ring with at least one nitrogen. These are classifiable in class 548, subclass various.
- IV. The compounds according to claim 1 of formula I, wherein  $R^3$  is six-membered heterocyclic ring with one nitrogen. These are classifiable in class 546, subclass various.
- V. The compounds according to claim 1 of formula I, wherein  $R^3$  is six-membered heterocyclic ring with at least two heteroatoms, at least one heteroatom being nitrogen. These are classifiable in class 544, subclass various.
- VI. The compounds according to claim 1 of formula I, wherein  $R^3$  is sulfur containing heterocyclic rings with no (0) nitrogen ring members. These are classifiable in class 549, subclass 1+.
- VII. The compounds according to claim 1 of formula I, wherein  $R^3$  is oxygen

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containing heterocyclic rings with no (0) nitrogen or sulfur ring members.

These are classifiable in class 549, subclass 200+.

- VIII. The compounds according to claim 1 of formula I, wherein  $R^3$  is seven-membered or larger, nitrogen containing heterocyclic rings. These are classifiable in class 540, subclass various.
- IX. The method according to claims 25-30, wherein  $R^3$  is H, alkyl,  $-N=CR''$ ,  $-C(O)R'$ ,  $-C(O)NR'R''$ , or  $-NR'R''$ . The claims are drawn to a method of treatment that is classifiable in class 514.
- X. The method according to claims 25-30, wherein  $R^3$  is an aryl. The claims are drawn to a method of treatment that is classifiable in class 514.
- XI. The method according to claims 25-30, wherein  $R^3$  is five-membered heterocyclic ring with at least one nitrogen. The claims are drawn to a method of treatment that is classifiable in class 514.
- XII. The method according to claims 25-30, wherein  $R^3$  is six-membered heterocyclic ring with one nitrogen. The claims are drawn to a method of treatment that is classifiable in class 514.
- XIII. The method according to claims 25-30, wherein  $R^3$  is six-membered heterocyclic ring with at least two heteroatoms, at least one heteroatom being nitrogen. The claims are drawn to a method of treatment that is classifiable in class 514.
- XIV. The method according to claims 25-30, wherein  $R^3$  is sulfur

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containing heterocyclic rings with no (0) nitrogen ring members. The claims are drawn to a method of treatment that is classifiable in class 514.

XV. The method according to claims 25-30, wherein  $R^3$  is oxygen containing heterocyclic rings with no (0) nitrogen or sulfur ring members . The claims are drawn to a method of treatment that is classifiable in class 514.

XVI. The method according to claims 25-30, wherein  $R^3$  is seven-membered or larger, nitrogen containing heterocyclic rings. The claims are drawn to a method of treatment that is classifiable in class 514.

The pharmaceutical composition of Claim 24 will be examined along with the elected group.

Inventions in Groups I-VIII and Groups IX-XVI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different process, such as treating inflammatory diseases.

The inventions of Groups I-XVI are separate and patentably distinct because there is no patentable co-action among them and a reference anticipating or rendering obvious one member will not anticipate or render another obvious.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, a search of the sixteen groups designated above would impose an undue burden upon the examiner, and restriction for examination purposes as indicated is proper.

A telephone call was made to Peter Herridge on March 22, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is requested to elect a specifically disclosed species of the invention to be examined for search purposes.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**DEEPAK RAO**  
**PRIMARY EXAMINER**

For

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James O. Wilson  
Supervisory Patent Examiner  
Technology Center 1600